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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/660,340 | 09/11/2003 | David L. Patton | 86552DMW | 5136 |

7590 10/06/2004

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| EXAMINER |
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SMITH, ARTHUR A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2851

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,340

Applicant(s)

PATTON ET AL.

Examiner

Arthur A Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/11/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

Reference WO 01/13301 was not considered since a copy was not filed with the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 7-9, 11-15, 17-19, 21-27, 29-33, 35-38, 40-42 and 44-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Sprogis (US 2004/00478268 A1).

In reference to claims 1, 4, 8, 9, 11, 12, 18, 19, 21, 22, 26, 30-33, 35-37, 41, 42 and 47, Sprogis discloses a method for scheduling motion picture and promotional content to an audience at an exhibitor site, paragraph 29, the method comprising: assembling an electronic play list for the motion picture and for related promotional content, said play list identifying at least one time slot for presentation of promotional content, paragraphs 95, 101 and 114; posting an electronic notice soliciting a bid from an advertisement provider for purchase of said at least one time slot (posting is continuous since all accounts can see available slots note specific postings made when

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slot filled or more space becomes available, paragraph 122); in response to a received bid, associating an advertisement from said advertisement provider with said at least one time slot in said play list, paragraph 122; and acquiring said advertisement electronically from said advertisement provider, paragraph 33.

In reference to claims 2, 3, 5, 7 13-15, 23-25, 27, 29, 38, 40 and 44-46, Sprogis discloses obtaining an audience metric associated with said exhibitor site; and providing said audience metric electronically to said advertisement provider, paragraph 35 and 109.

Claims 1-5, 7-9, 11-15, 17-19, 21-27, 29-33, 35-38, 40-42 and 44-47 are rejected under 35 U.S.C. 102(a) as being anticipated by Novation, Novad Leisure-Edition for Digital Cinema Advertising (Date of web page, 3/4/03, determined using www.waybackmachine.org and does not represent the absolute earliest publication date).

In reference to claims 1, 4, 8, 9, 11, 12, 18, 19, 21, 22, 26, 30-33, 35-37, 41, 42 and 47, Novation discloses a method for scheduling motion picture and promotional content to an audience at an exhibitor site, the method comprising: assembling an electronic play list for the motion picture and for related promotional content, said play list identifying at least one time slot for presentation of promotional content; posting an electronic notice soliciting a bid from an advertisement provider for purchase of said at least one time slot (posting is continuous); in response to a received bid, associating an advertisement from said advertisement provider with said at least one time slot in said

play list; and acquiring said advertisement electronically from said advertisement provider, see entire document.

In reference to claims 2, 3, 5, 7 13-15, 23-25, 27, 29, 38, 40 and 44-46, Sprogis discloses obtaining an audience metric associated with said exhibitor site; and providing said audience metric electronically to said advertisement provider, paragraph 35 and 109.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6, 10, 16, 20, 28, 34, 39 and 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Novation, Novad Leisure-Edition for Digital Cinema Advertising.

In reference to claims 6, 16, 28, Novation does not disclose wherein the step of inserting a new time slot is performed by an operator. Instead, Novation discloses that the time slots are generated through automation (software). It would have been obvious to one of ordinary skill in the art at the time the invention was made to realize that time slots could be generated manually. Broadly switching between mechanical or automatic means involves only routine skill in the art.

In reference to claims 10, 20, 34, 39, Novation does not disclose wherein advertising rate is based on an audience metric. It would have been obvious to one of ordinary skill in the art at the time of the invention to realize that the rate of advertising

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could be linked to the audience metric. This involves only simple economic principles. For example, advertising spots at the Super Bowl are sold at a premium because of previous data show the high volume of users.

In reference to claim 43, Novation does not specifically disclose wherein the commands are entered on a PDA. However, Novation does disclose that the entire system is accessible through the internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to thus realize that commands could be entered through a PDA since like a standard computer a PDA also has the capability of communicating through the internet.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thieste et al. (US 20040181819 A1) discloses a method for create a play list for a digital theatre in which advertisers are able to electronically purchase and transmit the advertisements. Eldering (US 6324519 B1) discloses a method that allows advertisers to electronic bid on space allocations during a television program to secure the space so that there advertisement can be electronic allotted that space. Avica masters Digital Cinema from post production to digital cinema delivery systems, shows the general architecture of a digital cinema.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur A Smith whose telephone number is (571) 272 2129. The examiner can normally be reached on Monday - Thursday from 8:00 AM to

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5:30 PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (572) 272 2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur A. Smith
September 30, 2004